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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Jacquelyn Annette Martino et al.
SERIAL NO. : 09/282,320 EXAMINER : George Eng
FILED : March 31, 1999 ART UNIT : 2643
FOR : MIRROR BASED INTERFACE FOR COMPUTER VISION
APPLICATION

SUPPLEMENTAL REPLY BRIEF TRANSMITTAL LETTER

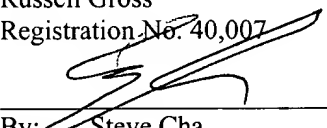
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

Appellants respectfully submit three copies of a Reply Brief For Appellants that includes an Appendix with the pending claims. The Supplemental Reply Brief is now due on April 18, 2005 as April 17, 2005 falls on a Sunday.

Should the Examiner deem that there are any issues which may be best resolved by telephone communication, kindly telephone Applicants undersigned representative at the number listed below.

Respectfully submitted,
Russell Gross
Registration No. 40,007


By: Steve Cha
Attorney for Applicant
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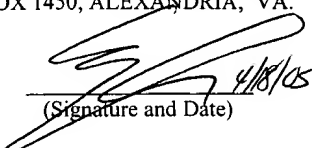
Date: April 18, 2005

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Steve Cha, Reg. No. 44,069
(Name of Registered Rep.)


(Signature and Date)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

In re the Application

Inventor : **Jacquelyn Annette Martino et al.**
Application No. : **09/282,320**
Filed : **March 31, 1999**
For : **MIRROR BASED INTERFACE FOR COMPUTER
VISION APPLICATIONS**

SUPPLEMENTAL REPLY BRIEF

On Appeal from Group Art Unit 2643

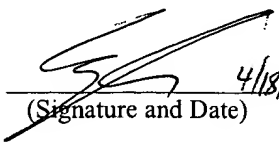
Date: April 18, 2005

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Steve Cha, Reg. No. 44,069
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(Signature and Date)

4/18/05

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I. REAL PARTY IN INTEREST

Reference is made to the Appeal Brief.

II. RELATED APPEALS AND INTERFERENCES

Reference is made to the Appeal Brief.

III. STATUS OF CLAIMS

Reference is made to the Appeal Brief

IV. STATUS OF AMENDMENTS

Reference is made to the Appeal Brief.

V. SUMMARY OF THE INVENTION

Reference is made to the Appeal Brief.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Reference is made to the Appeal Brief

VII. ARGUMENT

- 1) **Rejection of the claims under 35 U.S.C. §103(a) over Kamaya in view of Baumgarten and Janow**

In response to the arguments provided in the Examiner's Supplemental Reply dated February 18, 2004, applicant respectfully submits that the Supplemental Reply fails

to show how the combination of the Kamaya, Baumgarten and Janow references render obvious the subject matter claimed.

The Supplemental Examiner's Answer maintains the reason for the rejection of the above refereed to claims found in the Final Office Action, dated June 16, 2004, and the Examiner's Answer, dated November 30, 2004. The Supplemental Examiner's Answer more specifically states that "the test [for obviousness] is what the combined teachings of the references would have suggested to those of ordinary skill in the art. ... Baumgarten clearly discloses an image generating device (4, figure 5) for quickly and easily inspecting user's own appearance including a framing mirror (24, figure 5) having a reflection surface, that is substantially greater than the lens surface, in front of a camera (70, figure 5), so that the mirror is movably arranged at an angle to the camera (col. 3, lines 29-51), wherein the mirror comprises a two-way transparent center area, i.e., a hole (80, figure 5), located at the center area of the mirror (40, figure 5), to permit the camera to capture [an] image, thereby increasing the clarity of the video signal (col. 6, lines 1-14). Thus, one ... would have been motivated to make the modification to Kamaya ... in order to let users quickly and easily inspect their own appearance...." (see Examiner's Supplemental Answer, page 3, line 13 - page 4, line 3).

However, applicant respectfully submits that the law is clear that there must be some teaching in the reference to support their use in the particular claimed combination. See Smithkline Diagnostics, Inc., v. Helena Labs Corp., 859 F.2d 878, 887, 8 USPQ 2d 1468, 1475 (Fed. Cir. (1988)). In order to establish a *prima facie* case of obviousness, three basic criteria must be met;

1. there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or combine the reference teachings;

2. there must be a reasonable expectation of success; and
3. the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Baumgarten discloses a method for generating images of a computer user and the surrounding area behind the user by using a mirror (24) having a reflecting surface (32) and a support (22) supporting the mirror. The mirror (24) includes side reflecting surfaces (38, 40) and a central reflecting portion (36). The central reflecting portion (36) is preferably configured to reflect an image of the computer user. (see col. 3, lines 59-65).

A reading to col. 3, lines 29-51, referred to by the Answer states:

Referring to FIGS. 2-4, image generating device 4 comprises a base housing 20 mounted on a support 22 and a mirror 24 attached to one side of base housing 20. Support 22 includes an upright member 26 joined at its bottom end 28 into a generally horizontal base member 30. Base member 30 is preferably in the shape of a relatively thin flat plate for resting on a substantially planar surface, such as a desktop or a top surface of computer monitor 6. Base member 30 can also be mounted to a planar or non-planar surface by suitable fasteners ... Housing 20 is preferably pivotally mounted to upright member 26 (via, e.g., a swivel joint (not shown) around both the longitudinal axis of the upright member 26. This permits the user to pivot housing 20 and mirror 24 up and down and from side to side to change the viewing angle of the image reflected by mirror 24. In this manner, the device will accommodate a variety of users' sitting positions and heights and will allow the user to change the image reflected by mirror 24. Additionally or alternatively, upright member 26 may include extensions for adjusting the vertical distance between mirror 24 and the planar support surface. (emphasis added)

Hence, Baumgarten teaches that the mirror (24) may be adjusted horizontally and vertically. But fails to show how the mirror is movably arranged at an angle to the camera, as is recited in the claims. In fact, Baumgarten is silent with regard to the mirror movably arranged with regard to the camera.

In an alternative embodiment, Baumgarten (figure 5) teaches that the camera is positioned with regard to the hole (80) in the central portion (36). In this position, the camera is fixed with respect to the hole and the surrounding mirror as any other position would prevent the camera from capturing the user's image. Hence, if the mirror is moved or repositioned the relative position of the camera remains the same.

Accordingly, Baumgarten fails to teach or suggest a mirror movably arranged with respect to the camera, from either the section of the Baumgarten reference quoted above, or the embodiment shown in figure 5 of the Baumgarten reference, to incorporate a movably arranged mirror to the device of Kamaya, as suggested by the Final Office Action and subsequent Examiner's Answers. .

Applicant respectfully submits that Baumgarten fails to provide a mirror movably arranged at an angle to the camera, and that the teachings of Baumgarten may be properly individually challenged to shown why a *prima facie* case of obviousness has not been set forth with regard to the rejection of claim 1.

Applicant would note, however, that Baumgarten discloses a movable cover 50 (figure 3), which is used "for blocking portions of the reflecting surface 32. (see col. 4, lines 35-36). Cover 50 is attached to an upper track for "allowing cover 50 to be translated along upper edge 56 of mirror 24 to vary the sections of the image that are

blocked by cover 50.” (see col. 4, lines 41-43). Baumgarten further describes the use of cover (50) with regard to camera 70, in col. 6, lines 9-14, which state “[a]lternatively, cover 50 may have a mirror coating (not shown) so that the user can slide the cover over hole 80 to view the image of him or herself. During the videoconference, the user will slide the cover away from the hole 80 to expose videocamera 70”. (emphasis added). Hence, Baumgarten discloses a reflective or non-reflective movably arranged cover that prevents the camera from viewing the user positioned in front of the cover.

Assuming that the Final Office Action refers to the movable cover 50 as meeting the claims limitation “movably arranged at an angle to the camera,” applicant respectfully submits that the inclusion of a hole, as taught by Janow, in the movable cover 50, defeats the blocking purpose of the movable cover. For example, inclusion of a hole or two-way transparent solid area in the mirror cover 50 would preclude the user from blocking the videocamera 70 from viewing the user through hole 80.

Applicant respectfully submits that Manual of Patent Examining Procedure (MPEP), Eight Edition, Rev. 2, May 2004, provides appropriate instruction such modification should be judged. MPEP §2143.01 provides in the subsections entitled:

The Proposed Modification Cannot Change The Principle Of Operation Of A Reference.

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious” (*In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). MPEP §2143.01, p. 2100-132.

Hence, the incorporation of the two-way transparency of Janow into the cover of Blumgarten would change the principle of operation of the blocking cover 50.

Accordingly, applicant submits that a *prima facie* case of obviousness has not been set forth with regard to the rejection of claim 1 if the movable cover is assumed to meet the elements recited in claim 1.

Applicant would further submit that with regard to obviousness “[t]he very ease with which the invention can be understood may prompt one to fall victim to the ... effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.” Iron Grip Barbell Company v. USA Sports, Inc., Docket no. 04-1149, Dec. 14, 2004, p. 4, (Fed.Cir. 2004), (quoting In re Kotzab, 217 F.3d 1365, 1369 (Fed. Cir. 2000). “Where an invention is contended to be obvious ... our cases require that there be a suggestion, motivation or teaching ... for such a combination.” *Id.* at 5 (quoting In re Fine, at 1074 (Fed. Cir. 1988). “This requirement prevents the use of ‘the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight.’” *Id.* (quoting Ecolchem, Inc. v. So. Cal. Edison Co., 227 F.3d 1361, 1371-1372 (Fed. Cir. 2000), quoting In re Dembiczak, 175 F. 3d 994, 999 (Fed. Cir.1999)).

Applicant believes that, in this case, the cited references have been impermissibly combined using the teachings of the instant application as a blueprint without any suggestion or reason for such combination from any of the references.

Accordingly, the combination of Baumgarten, Kamaya and Janow fails to disclose or suggest the above-quoted recitation of instant claim 1. Nor would a person of ordinary

skill in the art found any suggestion by Janow to modify the combination of teachings of Baumgarten and Kamaya.

For at least the above reasons, Applicants respectfully submit that instant claim 1 would not have been obvious to an artisan over the combination of Baumgarten, Kamaya and Janow. Reconsideration and withdrawal of this ground of rejection are respectfully requested.

Applicants respectfully submit that independent claims 11, 15 and 18 have been previously amended in a similar fashion as instant claim 1, and these claims would not be obvious over the combination of Baumgarten, Kamaya and Janow for at least the above-reasons that traversed the rejection of instant claim 1.

In addition, with regard to the dependent claims these claims are believed to be allowable at least for their dependence upon an independent claim believed to be allowable, as well as because of an independent basis for patentability.

Accordingly, reversal of all grounds of rejection under 35 U.S.C. §103(a) by the Honorable Board are requested in light of the foregoing.

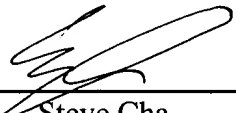
VIII. CONCLUSION

In view of the above analysis, it is respectfully submitted that the referenced teachings taken in combination fail render obvious the subject matter of any of the present claims. Therefore, reversal of all outstanding grounds of rejection is respectfully solicited.

Respectfully submitted,

Russell Gross
Registration No. 40,007

Date: April 18, 2005


By: Steve Cha
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Registration No. 44,069

APPENDIX: THE CLAIMS ON APPEAL

Reference is made to the Appeal Brief.